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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,229	04/20/2000	ROLF BRANDENBERGER	08846-076001	8809

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EXAMINER

SINGH, SUNIL

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 09/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

8:30 }
2:00 }

cls. lines 5-15
2 lines 29-32

[Handwritten signature]

Office Action Summary

Application No.

09/508,229

Applicant(s)

Brandenberger et al.

Examiner

Sunil Singh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 7, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

The restriction requirements made in office actions mailed 4/25/01 and 1/01/2002 have been withdrawn and claims 1-20 have been examined.

Specification

The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to "Microfiche Appendix" and the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-References to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Microfiche Appendix" (see 37 CFR 1.96).
- (e) Background of the Invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (I) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing (see 37 CFR 1.821-1.825).

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Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 18 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 requires for the **drainage means** to comprise a plastics mesh, an at least partially waterproof layer, **applied by spraying**, and a fibrous layer. However, nowhere in the disclosure is it disclosed that the waterproof layer of the **drainage means** is applied by spraying. For instance, page 1 line 20+ does not state that the partially waterproof layer is applied by spraying neither does page 3 line 10+.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 16 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claim 16 does not commensurate with the claim from which it depends from.

Claim 20 is confusing because it is not clear if it depends from claim 1 or 19.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 8-10 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Pulkkinen (US 4695188).

Pulkkinen discloses a cladding on a partially-overhanging substrate which comprises, in sequence starting from the substrate; a drainage means (15); a waterproofing membrane (12) and a layer of reinforcing (fibre) concrete (11). The substrate is given an initial layer of concrete (13)

With regards to claim 16, concrete (13) is considered as the fastening means used to secure said waterproofing membrane (12) to said drainage means (15).

With regards to claims 8,10,15 and 17, the recited method steps are considered to be inherent to the use of the apparatus disclosed by Pulkkinen.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 6, 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulkkinen '188.

Pulkkinen discloses the invention substantially as claimed. However, Pulkkinen is silent about the reinforcing concrete being sprayed. Sprayed reinforced concrete is old and well known in the art. It would have been considered obvious to one of ordinary skill in the art to modify Pulkkinen by spraying on the reinforced fibre concrete (11) since spraying on reinforced concrete is old and well known in the art. Furthermore, creating the cladding would be simpler since the waterproofing member as well as the initial concrete were sprayed on.

With regards to claim 14, the recited method steps are considered to be obvious in view of the rejection as described immediately above.

9. Claims 3, 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulkkinen in view of applicant's admission of prior art.

Pulkkinen discloses the invention substantially as claimed. However, Pulkkinen is silent about his drainage means comprising a plastics mesh, an at least partially waterproof layer and a fibrous layer. Applicant admits that it is known to have a drainage means comprising a plastics mesh, an at least partially waterproof layer and a fibrous layer (see applicant's specification page 3 lines 10-16). It would have been considered obvious to one of ordinary skill in the art to modify Pulkkinen by substituting the drainage means disclosed as being well known according to applicant's admission of prior art for the drainage means disclosed by Pulkkinen since it is a design choice to substitute equivalent parts for performing equivalent functions.

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10. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulkkinen in view of Japanese abstract (07097900).

Pulkkinen discloses the invention substantially as claimed. However, Pulkkinen is silent about the drainage means comprising layers of geotextile material with a waterproof film in between the layers of geotextile material. Japanese abstract '900 teaches drainage means comprising layers of geotextile material with a waterproof film in between the layers of geotextile material. It would have been considered obvious to one of ordinary skill in the art to modify Pulkkinen by substituting the drainage means as taught by Japanese abstract '900 for the drainage means disclosed by Pulkkinen since it is a design choice to substitute equivalent parts for performing equivalent functions.

11. Claims 1, 2, 4, 5, 8-10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wipo document (98/24738) in view of Bernold (US 3858400) or Pulkkinen '188.

Wipo document '738 discloses a cladding on a partially overhanging substrate which comprises in sequence starting from the substrate, an initial layer of concrete, a waterproofing membrane which has been applied thereto by spraying; and a layer of concrete. The waterproofing membrane is a plastics material with anchoring means for subsequent layers (see page 3). The waterproofing membrane is a layer of coalesced particles of thermoplastic polymer (see pages 2-3). The layer of concrete is applied by spraying (see page 4).

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Wipo document '738 discloses the invention substantially as claimed. However, Wipo document '738 is silent about including drainage means. Bernold and Pulkkinen both teach a cladding construction that includes a drainage means ((18), (15) respectively). It would have been considered obvious to one of ordinary skill in the art to modify Wipo '738 to include the drainage means taught by either Bernold or Pulkkinen in order to provide an added waterproofing means thus further preventing water from running into the tunnel or like members.

Response to Arguments

12. Applicant's arguments filed 6/7/02 have been fully considered but they are not persuasive. Applicant argues that Pulkkinen provides no "intermediate waterproofing membrane between his two layers of concrete. The examiner disagrees waterproofing member (12) is between concrete layers ((13), (11)).

Applicant argues that Pulkkinen "drainage means" is not a hydrophillic sheet, web or mesh. The examiner agrees since the examiner explicitly states that reference character (15) is considered as the drainage means.

Applicant argues that Pulkkinen outermost layer is not "concrete". The examiner disagrees since Pulkkinen explicitly states (see last line of abstract and col. 3 line 13) that the outermost layer (11) is concrete.

Applicant argues that WO 98/24738 is one which is useful "where little or no water seepage is encountered" therefore it would not be obvious to provide "drainage means". The examiner fails

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to see where such literature is located. Once again the examiner would like to point to page 1 paragraph 2 of WO 98/24738 wherein it discusses means of achieving waterproofing can be accomplished by either providing “drainage means” or by providing a waterproof membrane sandwich between concrete layers. Clearly, WO 98/24738 intends to waterproof a structure in at least two manners one by using drainage means and the other by using a waterproof membrane sandwich between concrete layers. Therefore, it would have been considered obvious to one skilled in the art to provide both means of waterproofing in order to ensure there is no leaking.

Applicant argues that Bernold does not teach a “drainage mesh”, “drainage fleece”. It should be noted that at least the independent claims are not limited to “drainage mesh”, “drainage fleece”; therefore, applicant’s arguments are far more limiting than the claimed subject matter.

Conclusion


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell, can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Sunil Singh



Patent Examiner

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9/25/02